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10/674,134

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Ronald P. Sansone

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EXAMINER

SALLIARD, SHANNON S

ART UNIT

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* RONALD P. SANSONE and ERIK MONSEN  
9

10  
11 Appeal 2009-006396  
12 Application 10/674,134  
13 Technology Center 3600  
14

15  
16 Decided: June 21, 2010  
17  
18

19  
20 *Before* MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.  
21 MOHANTY, *Administrative Patent Judges*.

22  
23 CRAWFORD, *Administrative Patent Judge*.  
24

25  
26 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Appellants appeal under 35 U.S.C. § 134 (2002) from a Final  
3 Rejection of claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b)  
4 (2002).

5 Appellants invented online systems and methods for making it easier  
6 for post offices to calculate accurately terminal dues by providing  
7 information to the post regarding each piece or parcel of mail that crosses  
8 and international border (Abstr.).

9 Independent claim 1 under appeal reads as follows:

10 1. A method for paying a carrier located in  
11 a second country for mail that has been deposited  
12 and paid for by a sender to a first carrier located in  
13 a first country to be delivered by a second carrier  
14 located in a second country to a recipient located  
15 in the second country, comprising the steps of:  
16 charging a sender's meter for mail that is  
17 being deposited with a first carrier;  
18 transmitting the funds charged to the meter  
19 to a meter data center;  
20 transmitting from the meter data center to a  
21 first carrier meter payment center located in the  
22 first country the funds attributable to the first and  
23 second carriers; and  
24 transmitting from the first meter payment  
25 data center to the second meter payment data  
26 center located in the second country the funds  
27 attributable to the second carrier.  
28

29 The prior art relied upon by the Examiner in rejecting the claims on  
30 appeal is:

31	Wade	US 2003/0009351 A1	Jan. 9, 2003
32	Konick	US 2003/0115162 A1	Jun. 19, 2003
33	Ashaari	US 2004/0188522 A1	Sep. 30, 2004

1	Kadaba	US 2004/0215480 A1	Oct. 28, 2004
2	Brookner	US 7,120,610 B1	Oct. 10, 2006

3 The Examiner rejected claims 1, 2, 4, and 8 under 35 U.S.C. § 103(a)  
4 as being unpatentable over Kadaba in view of Brookner; rejected claims 3  
5 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Kadaba in view  
6 of Brookner and Konick; rejected claims 6 and 7 under 35 U.S.C. § 103(a)  
7 as being unpatentable over Kadaba in view of Brookner and Wade; rejected  
8 claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Kadaba in view  
9 of Brookner, Wade, and Ashaari; rejected claim 10 under 35 U.S.C. § 103(a)  
10 as being unpatentable over Kadaba in view of Brookner, Wade, Ashaari, and  
11 Official Notice.

12 We AFFIRM.

#### 14 ISSUES

15 Did the Examiner err in asserting that a combination of Kadaba and  
16 Brookner renders obvious the subject matter of claims 1, 2, 4, and 8?

17 Did the Examiner err in asserting that a combination of Kadaba,  
18 Brookner, Konick, Wade, and Ashaari renders obvious the subject matter of  
19 claims 3, 5-7, and 9-10?

#### 21 FINDINGS OF FACT

##### 22 *Kadaba*

23 The barcode 37 could be an alphanumeric code, or other symbol, that  
24 is unique to the package ([0062]).

25 Billing by the second carrier is implemented by a portion the second  
26 carrier computer system 23 which is connected in communication with the  
27 verification system 43 and is configured to receive the daily manifest

1 therefrom. Also connected in communication with the second carrier  
2 computer system 23 is an escrow account 229 (set up at initiation of the  
3 system 10) from which the second carrier can withdraw funds for payment  
4 of the fees associated with each daily manifest. In this manner, the second  
5 carrier always has immediate access to funds once it has received and  
6 completed auditing of the daily manifest ([0098]).

7         Payment by the shipper 11, preferably electronically by the shipper  
8 computer system 20, is transmitted to the first carrier billing system 225.  
9 The first carrier billing system deducts the charges for the first carrier's  
10 services (which may also include charges required by the line-haul carrier  
11 13) and forwards the remaining amount, preferably electronically, to the  
12 escrow account 229. Advantageously, the escrow account is available for  
13 debit by the second carrier at any time, further bolstering the second carrier's  
14 confidence that compensation is being received for its delivery services  
15 ([0103]).

16  
17         *Wade*

18         The elapsed time data of Carrier 1 and Carrier 2 are then sent to a  
19 central processor which processes the data in accordance with a set of rules,  
20 thereby determining a periodic balancing payment 300 ([0034]).

21         At step 450, the mailpiece is received by the foreign country. D Scan  
22 records receipt of the mail piece at that point ([0039]).

23  
24         *Ashaari*

25         At stage 1130, the system may perform one or more in-process scans  
26 and matches, notifying mailer of the shipment status ([0077]).

PRINCIPLES OF LAW

*Obviousness*

Once a prima facie case of obviousness is established, the burden shifts to appellant to rebut it. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

One cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *Id.*

*Claim Construction*

While the specification can be examined for proper context of a claim term, limitations from the specification will not be imported into the claims. *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005).

ANALYSIS

*Claims 1, 2, 4, and 8*

We are not persuaded that the Examiner erred in asserting that a combination of Kadaba and Brookner renders obvious the subject matter of claims 1, 2, 4, and 8 (App. Br. 7-12). Appellant asserts that neither Kadaba nor Brookner discloses “the payment of funds to a first carrier meter payment center located in a first country and the transfer of funds to a second meter payment center located in a second country.” However, Kadaba discloses first carrier billing system 225 and escrow account 229, which correspond to the first and second meter payment centers. While Kadaba does not disclose that these payment centers are located in different countries, the Examiner asserts that

1 it is well known by one of ordinary skill in the art  
2 at the time of the invention that mail is delivered  
3 internationally using more than one shipper. For  
4 example, a package being delivered from the US to  
5 France would utilize the services of the USPS for  
6 initial handling and La Poste (French Postal  
7 Service) for final delivery. Therefore, it would  
8 have been obvious to one of ordinary skill in the  
9 art at the time of the invention to modify the  
10 invention of Kadaba to include a first carrier  
11 located in a first country and a second carrier  
12 located in a second country to be able to  
13 accommodate more customers thereby increasing  
14 revenue.

15 (Exam'r's Ans. 4). Appellants have not challenged the Examiner's rationale  
16 for modifying Kadaba to meet the first and second meter payment centers  
17 being located in different countries. *See In re Keller*, 642 F.2d at 426.

18 Appellants also assert that the claimed invention overcomes several  
19 disadvantages of the prior art (App. Br. 9-10). However, the advantages of  
20 overcoming such disadvantages are not set forth in the claims. *See*  
21 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231. Moreover, since  
22 the Examiner has set forth a prima facie case of obviousness for the claimed  
23 invention, the Examiner's combination inherently has the same advantages.  
24 *See, e.g., Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801,  
25 809-10 (Fed. Cir. 2002) (“[s]uppose Inventor B discovers that the polish also  
26 repels water when rubbed onto shoes. Inventor B could not likely claim a  
27 method of using the polish to repel water on shoes because repelling water is  
28 inherent in the normal use of the polish to shine shoes.”).

1           *Claims 3, 5-7, and 9-10*

2           We are not persuaded that the Examiner erred in asserting that a  
3 combination of Kadaba, Brookner, Konick, Wade, and Ashaari renders  
4 obvious the subject matter of claims 3, 5-7, and 9-10 (App. Br. 12-18). For  
5 claims 3 and 5, Kadaba, and not Konick, is cited for paying the first and  
6 second carriers the funds attributable to their costs. *In re Keller*, 642 F.2d at  
7 426. Konick is merely cited for disclosing special services, as recited in  
8 claims 3 and 5.

9           For claim 6, Kadaba discloses that “the escrow account is available  
10 for debit by the second carrier at any time” ([0103]). Wade discloses  
11 mailpieces are scanned when they are received in the foreign country and  
12 that this data is used to determine payments ([0034], [0039]). Accordingly,  
13 the payments can be sent from the first meter payment center to the second  
14 meter payment center at any time, for example, when the mailpiece is  
15 scanned in the foreign country.

16           For claim 7, Kadaba discloses barcode 37, which corresponds to the  
17 recited “placing a unique identification code on the mail to uniquely identify  
18 the mail.”

19           For claim 9, Wade is cited for scanning the mailpiece when it arrives  
20 in the second country, and Ashaari is cited for notifying the mailer when the  
21 mailpiece is scanned. *See In re Keller*, 642 F.2d at 426.

22

23

## DECISION

24

The decision of the Examiner to reject claims 1-10 is affirmed.

No time period for taking any subsequent action in connection with  
this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
§ 1.136(a)(1)(iv) (2007).

AFFIRMED

hh

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